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IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

No. ~~992~~ 132

INTERNATIONAL LATEX CORPORATION,
Petitioner.

v.

THE WARNER BROTHERS COMPANY,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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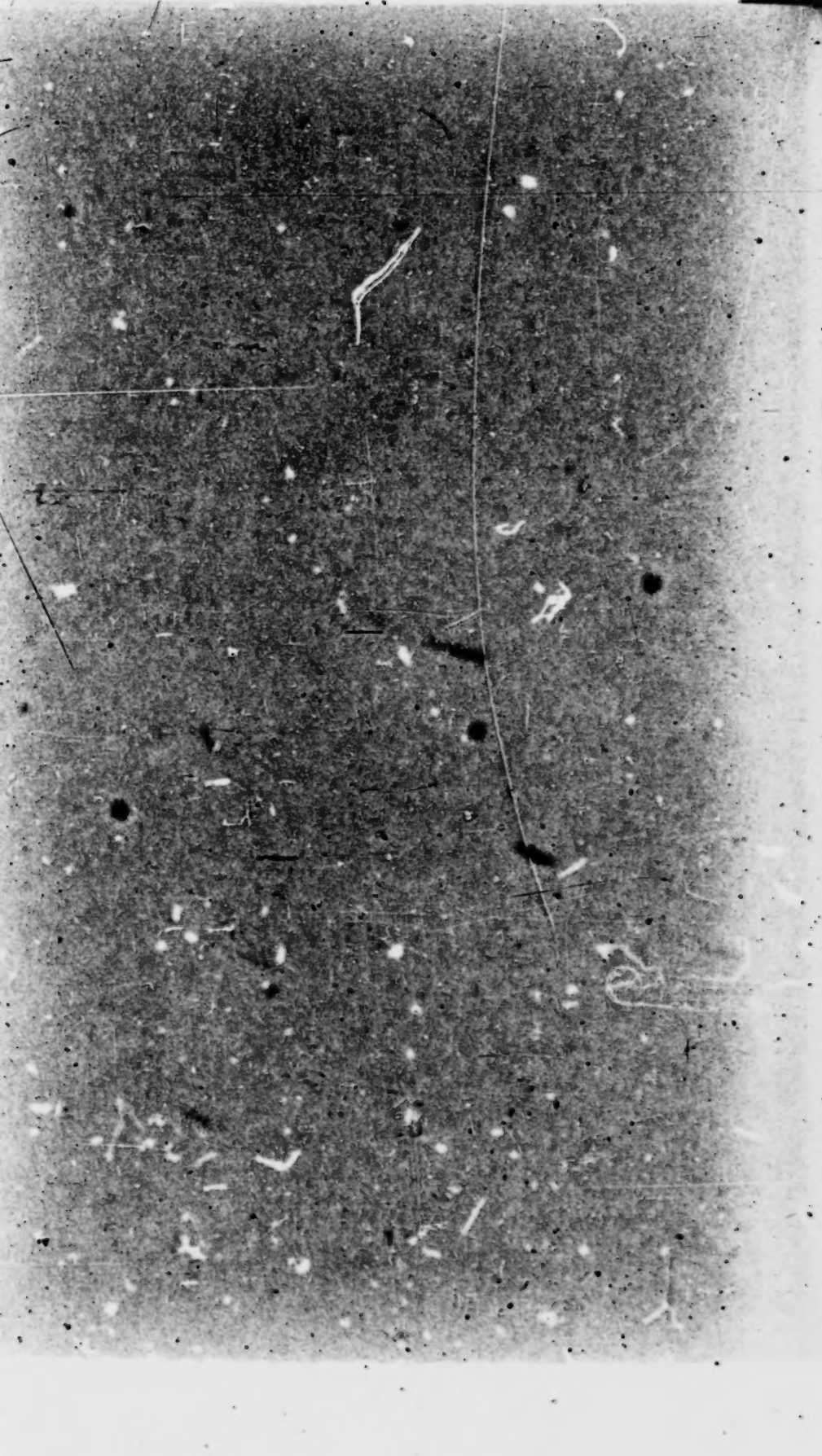
June, 1960



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INTERNATIONAL LATEX CORPORATION, *Petitioner*, v. THE WARNER BROTHERS COMPANY, *Respondent.*	No. 992

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

This is an ordinary patent suit.

The petition asks for review of the question of the fact finding of noninfringement of claims 1, 2 and 6 of a Spanel patent 2,360,736, owned by petitioner, application filed June 26, 1940 and issued October 17, 1944. The patent relates to rubber girdles, or corsets, and expires next year.

The district court and the Court of Appeals each found that these claims were not infringed.

There is no conflict of decisions.

There is no question of general interest or public importance.

1. Opinions below.

The Connecticut district court (Judge Anderson) decided that all four patent claims then in suit, 1, 2, 3 and 6, were valid, that claims 1, 2 and 6 were not infringed, and that claim 3 was infringed, 169 F. Supp. 755.

The Court of Appeals for the Second Circuit (Circuit Judges Lumbard, Moore and Friendly) affirmed except

that claim 3 was found not infringed, 2 Cir., 276 F. 2d 557.

Plaintiff filed a petition for rehearing with respect to only claims 1, 2 and 6. The Court of Appeals, unanimously, denied this petition on March 29, 1960.

The present petition was not filed until June 8, 1960.

2. Jurisdiction.

This Court has jurisdiction, by Title 28 USCA, Sec. 1254(1), but does not exercise it for such a case as here presented.

Keller v. *Adams-Campbell Company*, 264 U. S. 314, 319:

> "Such an ordinary patent case, with the usual issues of invention, breadth of claims, and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent."

Magnum Import Co. v. *Coty*, 262 U. S. 159, 163:

> "The jurisdiction to bring up cases by certiorari from the Circuit Courts of Appeals was given for two purposes; first, to secure uniformity of decision between those courts in the nine circuits; and, second, to bring up cases involving questions of importance which it is in the public interest to have decided by this court of last resort. The jurisdiction was not conferred upon this court merely to give the defeated party in the Circuit Court of Appeals another hearing."

Statement of the Case and Argument.

The patent describes a latex dipped girdle, and three subsidiary features which can be used, if desired.

Claims 1, 2 and 6 of the Spanel patent, for one of these features, are the subject of the petition.

In the prosecution of the application, claims were presented to the broad concept of making a rubber girdle by dipping a girdle shaped mold (form) into a tank of latex fluid, withdrawing the mold, and stripping the coagulated latex in the shape of a girdle. All such claims were rejected, and applicant, instead of appealing, acquiesced in the decision by accepting the six narrow claims of the patent.

Each claim is based upon the use, in a latex dipped girdle, of a specific feature. The claims were granted only because of such features. Claim 6 has the feature of a roughened inner (next to the skin) latex surface; claim 3, a long crotch; and claims 4 and 5, garters integral with the girdle.

Only claims 1, 2 and 6, which are substantially the same, require consideration here.

A smooth rubber surface next to the skin is clammy, cold and uncomfortable. Petitioner, realizing this, proposed to make the rubber more comfortable by roughening it, so that the girdles would have rough rubber (latex) inner surfaces, next to the skin. Accordingly, shortly before the patent application was filed, petitioner sand-blasted one surface of the girdle molds (forms), thus obtaining girdles with roughened rubber inner surfaces (stipulation, deft's. Ex. H; Deft's. App. 83a, 86a, 87a). The application as filed, and the patent describe this roughened rubber surface (pat., p. 6, first col., ll. 19-21, 29-35; sec. col., ll. 14, 15). It is the subject of claims 1, 2 and 6.

However, apparently plaintiff discovered some time after the application was filed in June, 1940, that rough rubber next to the skin was, if not worse than smooth rubber, because the rough rubber clung closer to the skin, at least no better. Plaintiff has never sold a girdle with a rough rubber inner surface.

Beginning in 1939 and through 1950, all girdles sold by plaintiff, totaling about 12 million girdles (finding of fact,

PA 376a), had smooth inner surfaces (stipulation, deft's. Ex., DA 82a). Although there was a demand for latex dipped girdles, by the purchasers of plaintiff's latex dipped baby pants and by others, it is plain that these large sales, on which petitioner relied, did not establish commercial success of claims 1, 2 and 6.

A. The idea of latex dipped girdles was not a patentable invention, and was suggested to Spanel by users of latex dipped baby pants.

Petitioner contends that the alleged invention of claims 1, 2 and 6 "advanced the art substantially" (petit., p. 7); and was "a concededly significant invention" (id., p. 10), although respondent has always denied, and now denies that it was either "significant" or an "invention". The record shows that, even if claims 1, 2 and 6 rise to the dignity of a patentable invention "The case is one where, in view of the state of the art, the invention must be restricted to the form shown and described by the patentee", *Duff* v. *Sterling Pump Co.*, 107 U. S. 636, 639; *General Bronze* v. *Cupples Products*, 8 Cir., 189 F. 2d 154, 159, etc., etc.

The art in the present case includes a widespread knowledge of making rubber articles, by dipping molds, pressing in molds, spraying, etc. Such articles were made either from rubber particles obtained from the original latex fluid, or directly from the latex fluid, in which latter case they were often referred to as "latex rubber" or "latex".

Latex dipping was used to make many kinds of articles, such as gloves, shoes, bathing caps, baby pants, etc., etc. (deft's. Ex. A, PA 367a-369a). Prior to 1940, petitioner made and sold latex dipped baby pants, which were made the same way as latex dipped girdles. A mold (form) was dipped into a tank of latex fluid, the mold was withdrawn and the coagulated latex was stripped from the mold. Purchasers of petitioner's baby pants suggested to petitioner

that it add girdles to its line, which petitioner then did, using the same apparatus and process as in making baby pants (DA 80a, 82a). That was not patentable invention.

The prior patents of Young et al., 1,923,524 (PA 284a), Charnaux 1,729,502 (PA 267a) and Clark 2,196,492 (PA 286a), all disclose rubber girdles or corsets. The courts below did not think that they invalidated the broad concept of the Spanel patent because of differences that respondent believes were immaterial. But, whether or not the patents were full anticipations, they clearly established that the idea of making girdles or corsets of rubber, instead of fabric, was not new in 1939, and, therefore, that subsequent patent claims should not be broadly construed as for a primary invention.

B. The Patent Office decided that the broad concept of a latex dipped girdle was unpatentable, and reluctantly allowed only specific claims, including claims 1, 2 and 6.

The application had a long and troubled career in the Patent Office, because the examiner took a dim view of there being any invention in any of the claims urged for patenting. It was only after repeated and lengthy arguments that finally he allowed claims 1, 2 and 6, and the other claims in the patent. Briefly, the application was filed June 26, 1940 with 35 claims (file history, deft's. Ex. L); examiner's action of November 8, 1941 rejected all claims (the application then became abandoned because of lack of timely response, but was revived); amendment of June 9, 1942 cancelled all claims and "new claims" 36 through 44 were filed (id., p. 59); action of October 24, 1942 rejected all claims (id., p. 71); amendment of April 6, 1943 cancelled all claims and added "new claims" 45 through 49 (id., p. 84); amendments of November 5, and 12, 1943, amended claims and argued for allowance (id., pp. 85 and 92); action of December 4, 1943 rejected all

claims (id. p. 97); and this rejection was then acquiesced in by a final amendment of April 17, 1944, cancelling all claims and substituting the narrow, limited claims now in the patent (id. p. 99), with immediate allowance on April 28, 1944 (id. 108).

Allowance of claims 1, 2 and 6 did not mean that the examiner thought it was patentable invention to have a rough rubber (latex) inner surface, but only that there was enough doubt to entitle the patentee—

> "to assert his *prima facie** right against infringers who may, in their defense, raise the question of the validity of the patent, and have the same finally adjudicated in the light of a full presentation and consideration of all the evidence attainable in respect of anticipation, prior knowledge, use, and the like", In re Thomson, 26 App. D. C. 419, 425; 120 O. G. 2756 (1906); *In re Meyer*, CCPA, 123 F. 2d 1021, 1023 (1941), and *In re de Groote*, CCPA, 127 F. 2d 322 (1942).

Undoubtedly, if the examiner had known that the subject of claims 1, 2 and 6 had never been used when petitioner's patent attorney represented that this was one of the reasons for "the very remarkable commercial success of the invention" (id. p. 86) he never would have allowed the claims.

With respect to the broad concept and claims 1, 2 and 6, the Patent Office decided that the broad concept was not patentable, repeatedly rejecting claims for this idea, such as claims 1 and 42:

> "1. As an article of manufacture, a *seamless, one-piece, latex girdle* in the form of a hollow flattened, truncated-cone shaped member in normal position, but adapted when pulled into position on the wearer's body to be stretched and to serve as an enclosing flesh-supporting sheath"

*Emphasis ours throughout.

> "42. As an article of manufacture, a *seamless, one-piece deposited latex supporting girdle* having a constricting front surface portion, and a constricting back surface portion, said portions smoothly merging into one another to provide transversely and longitudinally curved side portions".

The Patent Office refused to recognize invention in these (or similar) claims to the "broad concept", declaring that they did not "involve invention" (id., p. 41); "the particular material employed and the thickness thereof are not matters of invention" (id., p. 71); "To combine the teachings of these patentees does not amount to invention" (id., p. 84); and "nothing patentably novel" (id., p. 97).

After all the claims in the case, including all claims for Spanel's "broad concept", had been finally rejected, applicant had the statutory right to appeal this adverse decision and thereby obtain, by reversal, claims to the broad concept.

I. T. S. Co. v. *Esser Co.*, 272 U. S. 429:

> "If dissatisfied with the rejection he should pursue his remedy by appeal; and where, in order to get his patent, he accepts one with a narrower claim, he is bound by it" (p. 443).
>
> "So where an applicant whose claim is rejected on reference to a prior patent, without objection or appeal, voluntarily restricts himself by an amendment of his claim to a specific structure, having thus narrowed his claim in order to obtain a patent, he 'may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments which amount to a disclaimer'. *Weber Elec. Co.* v. *Freeman Elec. Co.*, 256 U. S. 668, 677." (p. 444).

In the present case, petitioner did not appeal the rejection, but acquiesced in it, by cancelling all claims, and submitting the narrow and limited claims of the patent, with the statement that they—

> "are not broadly directed to the mere use of an integral deposited latex construction, or to a mere change of material. Instead, the present claims are each limited to *specific features* which make practical such an integral deposited latex girdle, these features being the ones which are believed to have made possible *the very remarkable commercial success of the invention*" (pp. 85, 86).

The fact was that the "specific feature" of claims 1, 2 and 6 had not then, and never has been, used.

The courts below apparently did not recognize that "commercial success without invention will not make patentability", as said by this Court in *A. & P. Tea Co.* v. *Supermarket*, 340 U. S. 147, 153, where a patent was held invalid after two concurring decisions below that the patent was valid. In the present case, even if there had been "commercial success" of latex dipped girdles, that is not enough —the success must be "for the device defined by the" claims, *Altoona Publix Theatres* v. *American Tri-Ergon*, 294 U. S. 477, 488.

Claims 1, 2 and 6 were not entitled to "commercial success" to help their patentability, because millions of latex dipped girdles were sold without their presence. Respondent believes now, as heretofore, that these claims are invalid for want of invention, and that they never would have been allowed by the Patent Office if it had known that they were not used in plaintiff's girdles.

C. The fact issue of the doctrine of equivalents was found, correctly, for respondent in the trial court and affirmed by the Court of Appeals.

The petition asks this Court to review the findings of fact below that claims 1, 2 and 6 were not entitled to "the doctrine of equivalents" (petition, pp. 2, 6, 11, 14).

But equivalency is "a determination of fact", it is "an issue of fact", and that issue was found, on ample evidence, against petitioner, by a trial court that saw the witnesses, observed tests and was affirmed by a unanimous Court of Appeals.

Graver Mfg. Co. v. *Linde Co.*, 339 U. S. 605.

> "What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case" (p. 609).
>
> "A finding of equivalence is a determination of fact. Proof can be made in any form; through testimony of experts or others versed in the technology; by documents, including texts and treatises; and, of course, by the disclosures of the prior art. Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of evidence. It is to be decided by the trial court and that court's decision, under general principles of appellate review, should not be disturbed unless clearly erroneous. Particularly is this so in a field where so much depends upon familiarity with specific scientific problems and principles not usually contained in the general storehouse of knowledge and experience" (pp. 609-610).

The doctrine of equivalents is an exception, to the general rule that the patentee, who writes and proposes claims in his own language, must clearly and unequivocally warn the public of what he claims.

White v. *Dunbar*, 119 U. S. 47, 52:

> "The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."

United Carbon Co. v. *Binney & Smith Co.*, 317 U. S. 228, 236:

> "The statutory requirement of particularity and distinctiveness in claims is met only when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise. The zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field."

The exception of the doctrine of equivalency is applied only in cases of meritorious inventions, and then, only when—

> "two devices do the same work in substantially the same way, and accomplish substantially the same result, *Machine Co.* v. *Murphy*, 97 U. S. 120, 125" *Sanitary Refrigerator Co.* v. *Winters*, 280 U. S. 30, 42.

The district court, trier of the facts, found that defendant's girdles were not the equivalent of the girdles described in claims 1, 2 and 6. Defendant's fabric lining, called "flock", composed of comminuted fibres of cotton and the like, was not the same as roughened rubber, and did not act the same in a girdle. The Court of Appeals concurred, and denied a rehearing.

These findings should stand, unless clearly erroneous, especially as they were based upon the credibility of witnesses appearing before the judge, tests made in his presence and both physical and documentary exhibits, Fed. Rules Civ. Proc., 52a; *United States* v. *Gypsum Co.*, 333 U. S. 364, 394-395; *Commissioner* v. *Duberstein*, U. S. , 20 Sup. Ct. 1633, 1644 (June 13, 1960).

The fact evidence concerning equivalency included:

(1) The Spanel patent.

(2) Its Patent Office history.

(3) Many patents and publications.

(4) Defendant's alleged infringing girdles.

(5) Plaintiff's three specimens of sand-blasted and flocked material (plff's. Exs. 223, 224 and 226).

(6) Plaintiff's two small specimens of latex (Exs. 251-F and S).

(7) A stipulation concerning plaintiff's sand-blasted molds (deft's. Ex. H).

(8) Plaintiff's admissions concerning sand-blasted molds (deft's. Ex. I-I).

(9) The oral testimony of Ambrose, plaintiff's witness (PA 103a, 104a, 105a, 110a, 111a, and 117a).

(10) The oral testimony of Noble, defendant's witness (PA 190a through 202a; DA 19a).

(11) Plaintiff's tests in the trial court, witnessed by the trial judge (PA 192a-202a; 206a-214a).

Testimony concerning the differences, as a practical matter, between roughened rubber and a fabric lining on rubber included the following:

Flock fibres have a wicklike action in absorbing moisture,—roughened rubber does not (Noble, PA 192a).

Flock has "greater comfort" (Ambrose, DA 5a). Rubber next to the skin feels cold and clammy. A fabric lining does not.

Flock costs more and is more difficult to apply to a girdle than sand-blasting a form (Ambrose, DA 4a). Sand-blasted forms can be used "for a long time", to make many

girdles (Ambrose, DA 3a, 4a), and a lining of flock is useful for only one girdle.

There is danger of explosion when the finely divided flock fibres are put on the girdle (Ambrose, DA, 4a), which is not so with sand-blasted forms.

No rubber article in the record, including the rubber girdles of defendant, plaintiff, Kleinert, Miss Hollywood and Diana, have rough rubber inner surfaces next to the body—all have flock. Here, as in *New York Trust* v. *Eisner*, 256 U. S. 345, 349, a "page of history is worth a volume of logic".

Conclusion.

Petitioner, a private litigant, has had its day in court, on an ordinary patent, of minor importance. There is no conflict of circuits. The only error complained of is that the concurrent findings by the courts below were misapplications of the doctrine of equivalents to the totality of the unique and special facts in this particular case. They were not.

The petition should be denied.

Respectfully submitted,

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June, 1960